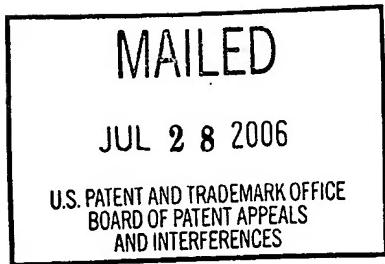


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte HORST RATHERT

Appeal No. 2006-0524
Application No. 10/051,577

ON BRIEF

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 8, 14, 19 and 20 pending in this application. Claims 4 to 7, 9 to 13 and 15 to 18 have been withdrawn from consideration.

The appellant's invention relates to a three-side trimmer for trimming blocks for hardback books and in brochures (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Sarring	3,722,336	Mar. 27, 1973
Mohr	5,279,196	Jan. 18, 1994

THE REJECTIONS

Claims 1, 2, 3, 8, 14, 19 and 20 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.

Claims 2, 14 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 1 to 3, 8 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sarring in view of Mohr.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed March 18, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed February 22, 2005) and reply brief (filed May 17, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1, 2, 3, 8, 14, 19 and 20 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. In support of this rejection, the examiner points to lines 10 and 11 of page 4 and states:

There are two problems with this part of the specification, the first part . . . being that it is not clear what forces are transmitted, and the second part. . . is that it is not clear how one would build such a device even if one did understand what forces are transmitted [answer at page 3].

At the outset, we note that an analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telecommunications, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth *supra* is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

In our view, the examiner has not explained why a person of ordinary skill in the art would not be able to construct the claimed trimmer, with some experimentation, having cutting units in a unit frame that substantially absorbs all flow of forces from the squeezing cut. We note in this regard that force and vibration analysis and absorption techniques are well known in the art.

The examiner also states that one reading the claims would not know how the pressing element adaptors work. Specifically, the examiner states that one of ordinary skill in the art would not know how the telescoping adaptors are shutter-like or accordion-like. We will not sustain this rejection because the claims on appeal do not recite adaptors which are shutter-like or accordion-like. Only claims 4 to 7 and 15 to 18, which have been withdrawn from consideration, recite "adaptors."

We turn next to the examiner's rejection of claims 2, 14 and 20 under 35 U.S.C. § 112, second paragraph. In support of this rejection, the examiner states that one of ordinary skill in the art would not be able to determine what forces are absorbed and that the term "substantially" is vague.

Appellant argues in the reply brief that the examiner's holding that the word "substantially" is vague was not in the final rejection and thus is a new ground of rejection. Appellant does not further comment on the meaning of the word "substantially."

We do not view this rejection as a new ground of rejection because the examiner in the final rejection made a rejection of these claims under 35 U.S.C. § 112, second paragraph and stated, in reference to the claim language: "absorbs substantially all forces," that it was unclear what forces were absorbed. In addition, we agree with the examiner that appellant's specification does not provide any guidance as to what might constitute a unit frame which *substantially* absorbs all flow of forces from the squeezing cut and it does not appear to us that this claim language has any clear meaning when read in light of the originally filed specification. Page 4 of the specification states that all pressing and cutting forces remain within the compact units. It is not clear whether this compact unit is the compact unit of claim 1 or the unit frame of claim 2. In any case, there is no guidance in the specification what the term *substantially* means, especially as the specification states that *all* the forces remain in compact units.

In view of the foregoing, we will sustain this rejection of the examiner of claim 2 and claim 14 which is dependent on claim 2 under 35 U.S.C. § 112, second paragraph. We will likewise sustain this rejection as it is directed to claim 20 because claim 20 also recites that the unit frame *substantially* absorbs all forces.

In regard to the examiner's rejection of claims 1 to 3, 8 and 20 under 35 U.S.C. § 103 as being unpatentable over Sarring and Mohr, we have already determined, above, that claims 2 and 20 are indefinite and further make reference to our new rejection infra where we explain why the claim limitation of a "closed compact unit" in claim 1 and claim 20 does not comply with the second paragraph of 35 U.S.C. § 112. Rejections based on 35 U.S.C. § 103 should not be based upon considerable speculation as to the meaning of terms employed and assumptions as to the scope of the claims In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we are constrained to reverse the examiner's rejection of claim 1 as well as claims 2, 3, 8, dependent thereon, and 20 as being unpatentable over Sarring and Mohr. This reversal is not based upon any evaluation of the merits thereon and does not preclude the examiner's advancement of a rejection predicated upon the applied prior art against a definite claim.

New Ground of Rejection

Pursuant to 37 CFR § 41.50(b), we enter the following new rejection.

Claims 1 to 3, 8, 14, 19 and 20 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

The test for compliance with the second paragraph of Section 112, is "whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct." In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975). In other words, does a claim reasonably apprise those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Independent claim 1 recites:

block head pressing element being a closed compact unit with a block head pressing drive. . .

block foot pressing element being a closed compact unit with a block foot pressing drive. . .

block front pressing element being a closed compact unit with a block front pressing drive. . .

We note that in Figures 2 and 3 the pressing units 15, 19 and 22 are not depicted as within what one would consider a closed unit with press driving elements 20. Rather, the pressing units 15, 19, and 22 appear to be intermingled with the surrounding elements.

Appellant states that the pressing elements along with the drive elements 20 are all connected to the unit frame 8 which connects all these elements to form the "closed compact unit" (reply brief at pages 6 to 7). However, as the unit is open at its front, back and top, it is not clear what the term "closed" means in claim 1. In addition, it is not clear what the term compact means in this context. In this regard, it is not clear what configuration would constitute compact as opposed to not compact.

Claims 2, 3, 8 and 14 depend from claim 1 and are likewise indefinite.

Claims 19 and 20 have similar language to claim 1 and thus are indefinite for the reasons stated in regard to claim 1.

In summary:

The examiner's rejection of claims 1, 2, 3, 8, 14, 19 and 20 under 35 U.S.C. § 112, first paragraph is not sustained.

The examiner's rejection of claims 2, 14 and 20 under 35 U.S.C. § 112, second paragraph is sustained.

The examiner's rejection of claims 1 to 3, 8 and 20 is not sustained on procedural grounds.

A new rejection of claims 1 to 3, 8, 14, 19 and 20 has been made.

In addition to affirming the examiner's rejection in regard to one or more claims, this opinion includes a new ground of rejection pursuant to 37 CFR § 41.50(b). A new

rejection pursuant to this paragraph shall not be considered final for judicial review.

Section 41.50(b) of 37 CFR also provides:

When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

If appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or second appeal, this case should be

returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 41.50(b)

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

Appeal No. 2006-0524
Application No. 10/051,577

Page 12

MCGLEW & TUTTLE, PC
P.O. BOX 9227
SCARBOROUGH STATION
SCARBOROUGH, NY 10510-9227

MEC/jrg